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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,008	11/15/2000	Johann Engelhardt	102847-28	1885

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EXAMINER

FERNANDEZ, KALIMAH

ART UNIT	PAPER NUMBER
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2881

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/681,008

Applicant(s)

ENGELHARDT, JOHANN

Examiner

Kalimah Fernandez

Art Unit

2881

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b))

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1, 2, 4-6 and 8-22.

Claim(s) withdrawn from consideration: _____


8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Continuation of 2. NOTE: the amendment to claim 1 is not objected to, however the amendment as a whole requires additional consideration and/or searching.

Continuation of 5. does NOT place the application in condition for allowance because: As explained in the office actions mailed on 1-30-02 and 7-31-02, the claimed invention is deemed an obvious variation of Stein ('874) apparatus. Whereas the difference between the claimed invention and the prior art is the scanning device being rotatable about a further axis is a mere obvious modification. Namely, as stated Stein teaches all the limitations of claim 1 except for a rotatable scanning device as recited. However, Montagu teaches a scanning device rotatable about a further axis as depicted in fig. 1c. Contrary to applicant's assertion, obvious motivation to incorporate the teachings of Montagu into Stein is found in Montagu (col.3, lines 8-37). Wherein, Montagu teaches improved auto-focusing for scanning microscope by employing a translation or rotation about an axis other than the optical axis (i.e. a further axis). In response to applicant's contention that the prior art fails to teach or obvious suggest "both elements rotatingly and linearly movable". This feature is not recited in proper claim language.

As per claim 4, applicant contends that col.8, lines 4-12 of Montagu suggest the distance between the scanning device and sample is not constant. However, in col.8, lines 4-12, the distance between the sample and scanning device is only altered during non-operative mode (i.e. when removing the slide). Contrary. Montagu's teaching of a pusher (46) acts to hold the scanning device at a constant distance when activated (see col.8, lines 15-29).

Applicant's argument regarding the remaining claims were considered but not found persuasive. Applicant asserts differences between the prior arts but fails to clearly point out the patentably distinguishable features in proper claim language to support these assertions.


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